

REMARKS

The Examiner's February 11, 2003, Office Action

In his February 11, 2003, Office Action, the Examiner objected to the drawings, provisionally rejected claims 1-20 under the judicially created doctrine of obviousness-type double patenting, and rejected claims 1-20 based on obviousness.

Remarks on the Revised Drawings and Specification

The Examiner identified several minor deficiencies in the drawings, which have been corrected as follows:

- The Examiner noted that the flowchart of Fig. 4 lacked a reference number and suggested that it be item 45, shown in Fig. 2. Applicant agrees and Fig. 4 has been so amended.
- The Examiner noted that the flowchart of Fig. 10 lacked a reference number and suggested that it be item 47, shown in Fig. 2. Applicant agrees that the flowchart of Fig. 10 corresponds to item 47 – but it is only *one embodiment* of item 47. Fig. 6 also corresponds to and is *another embodiment* of item 47. Accordingly, Figs. 6 and 10 have been amended to include the reference numbers 47a and 47b, respectively. The specification on page 14 has been likewise amended to include a reference to the newly added item 47b of Fig. 10.
- The Examiner noted that the flowchart of Fig. 11 lacked a reference number and suggested that it be item 48, shown in Fig. 2. Applicant agrees, and Fig. 11 has been so amended.
- The Examiner noted that the flowchart of Fig. 16 lacked a reference number and suggested that it be item 49, shown in Fig. 2. Applicant agrees, and Fig. 16 has been so amended.
- The Examiner noted that the flowchart of Fig. 20 lacked a reference number and suggested that it is either item 50, shown in Fig. 2, or item 128, shown in Fig. 19. Applicant believes that, in light of the specification, Fig. 20 clearly correlates most closely to item 50. Fig. 20 has been so amended.
- The Examiner noted that Fig. 6 is missing a reference number but did not know what it should be. As stated above, Fig. 6 corresponds to and is one of two embodiments of item 47. Therefore, Fig. 6 has been amended by adding the reference number 47a to the

flowchart. The specification on page 13 has been likewise amended to include a reference to the newly added item 47a of Fig. 6.

- The Examiner noted that Fig. 13 is identified by reference number 104 and wondered whether Fig. 13 is also being referenced by Fig. 12 item 100. Page 14, line 24 and Fig. 12 recite item 100 in functional terms – “create center profile.” Page 15, line 11 and Fig. 13 recite item 104 as referring to the “service center profile” itself. The Examiner correctly apprehends that Fig. 13 displays an *interface* for performing the function 100. Fig. 13 also depicts the components of one embodiment of a “service center profile” 104, including the “center name,” the “center number,” address, billing, and contact information, and a reference to a logo design 107. Therefore, Fig. 13 has been amended to add a “100” reference number to the interface box; but the reference number 104 is also being retained.
- The Examiner noted that Fig. 15 lacks a reference number but did not know what it should be. Fig. 15 has been amended to add a reference number 108, as Fig. 15 clearly provides an interface for the review and approve orders function 108 of Fig. 14.
- The Examiner noted that the flowchart of Fig. 17 lacked a reference number and suggested that it be item 117, shown in Fig. 16. Applicant agrees, and Fig. 17 has been so amended. Fig. 17 and the specification on page 16 corresponding thereto have also been amended to substitute the “129” for “123,” it being noted that “123” also appears in Figs. 18 and 19.
- The Examiner noted that the flowchart of Fig. 18 lacked a reference number and suggested that it be item 210, shown in Fig. 2. Applicant presumes that 210 is a typographical error and that the Examiner meant item 120. Fig. 18 has been amended to include the reference number 120 to its flowchart.
- The Examiner also objected to Fig. 18 because item 124 did not match the disclosure for item 124 on page 16. Applicant agrees and appreciates the Examiner’s detailed observations. Page 16, lines 18-19 state that “the processor preferably has access to the user profiles 126.” Clearly, this corresponds to the “view profile” option depicted in Fig. 18. Therefore, Fig. 18 has been amended to substitute reference number 126 for 124.
- The Examiner noted that the flowchart of Fig. 19 lacked a reference number and suggested that it corresponds with the box in Fig. 18 containing the text “view approved orders,” which also lacked a reference number. Applicant agrees. Fig. 18 has been amended to include the reference number 130 to the box reciting “view approved orders.” Also, reference number 130 has been added to Fig. 19, which depicts an interface for viewing the approved orders.
- The Examiner also objected to the drawings for using the reference character “127” in Fig. 18 to designate both “modify order” and “remove order.” Both Fig. 18 and Fig. 19

have accordingly been amended to use the reference character "127a" to designate the "modify order" and "127b" to designate the "remove order" functions/options. The corresponding paragraph of the specification on page 16 has also been amended to substitute references to "127a" and "127b" for the single reference previously provided to "127."

It is respectfully submitted that the amendments to the drawings and specification are fully supported by the original specification and add no new matter.

Provisional Obviousness Type Double Patenting Rejection -- Terminal Disclaimer

Attached please find a terminal disclaimer on PTO Form PTO/SB/25 to overcome the Examiner's provisional double patenting rejection.

Sevcik et al. does not acknowledge or eliminate inefficiencies in typesetting or proofing.

The Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Sevcik et al., U.S. Patent No. 6,330,542 B1, entitled "Automated Internet Quoting and Procurement System and Process for Commercial Printing." Applicant respectfully traverses the rejection.

Sevcik discloses an electronic-commerce system for obtaining *quotes* on various print products. It provides a *request-a-quote interface* enabling a user to specify various options, like the paper size, paper color, paper finish, paper weight, ink color, and binding type, and obtain quotes from competing print providers. The first paragraph of the specification neatly summarizes this aspect of Sevcik:

The system allows buyers of printing to receive immediate quotes by selecting simple graphic representations of the product they wish to purchase and selecting any variable information for that product. This procedure saves the buyer significant time and also saves the printing providers significant time in having to prepare the quote.

Col. 1, lines 15-22. Sevcik also discloses a *print provider interface* enabling competing print providers to furnish a “production availability profile and pricing structure, and current contact information.” Col. 14, lines 54-55; see also col. 16, line 3 to col. 17, line 45. After a user requests a quote for a specified item within a specified turnaround time to be delivered to a specified zip code, the system “searches the database . . . to find all vendors that have indicated being able to supply that item in the specified turnaround time and finds the ones closest to the delivery zip code” and then “searches for the lowest price for that quantity range and variable options among the vendors that have been identified.” Col. 9, lines 26-42.

Sevcik also briefly characterizes the system as enabling a print buyer to register and place print orders. According to Sevcik, the system prompts the buyer to provide credit card information and billing and shipping information. Col. 14, lines 8-48. Sevcik also describes the system as enabling both print buyers and providers to check, or provide information about, the job status of a pending order. Col. 14, lines 30 - col. 15, line 67.

Sevcik is an interesting reference. It proposes a system that would provide an efficiency to print providers, namely automating price quotes. It also provides an efficiency to print buyers, namely by providing them with product availability and pricing information from a variety of print providers. By allowing a print buyer to place an order and monitor the job status, the Sevcik system would also facilitate the initialization and job progress review of a transaction between a print buyer and a print provider.

But while Sevcik briefly suggests an interface to allow a print buyer to register and place orders, it does not even recognize, much less solve, the problems and inefficiencies of typesetting and proofing identified in the background section of Applicant’s specification:

Charges for business cards, stationery products and the like constitute a significant portion of any commercial enterprise's cost of doing business. Due, in general, *to the labor-intensive nature of type-setting* and, in particular, *to the necessity to specifically tailor each product to a particular user's identity and/or office location*, the actual printing costs associated with these items have traditionally far exceeded the costs associated with other print media. . . . [L]arge institutional and conglomerate users often find that a significant number of personnel must be dedicated solely to the functions of order preparation, approval, submission, *proofing*, receiving, receiving, *quality assurance* and distribution. . . .

From the printer's perspective, the processes involved in receiving an order, *typesetting a business card or stationery product and corresponding with the client to proof the order* are typically more involved, and consequently often more costly, than the actual printing of the order. To further the frustration felt by the printer, *the proofing process is ripe for dispute* with the client, leading too often to the difficult decision as to whether to reprint the order free of charge or risk loss of the client by billing on a disputed order. . . .

Clearly, there is a long-standing need for an improved print order system that eliminates these widely varied but unnecessarily cost-increasing functions. . . .

Page 2, line 10 – Page 3, line 13 (emphasis added).

Applicant's invention, unlike Sevcik, recognizes the typesetting and proofing problems and describes a system and method to solve them. Claim 1 is directed to an automated print order system that solves the typesetting and proofing problems by directly generating a pre-press product that automatically incorporates a "predeterminable profile" into a "company tailored product."

It is well established that the specification provides a context to illuminate the meaning of claim terms. *AbTox Inc. v. Exitron Corp.*, 122 F.3d 1019, 1023 (Fed. Cir. 1997). The "company tailored product" of claim 1 is described on pages 9-10 as comprising a business card, stationery product, or the like, having company-tailored graphics, text fields, and typographies (including the font size, type and style, kerning, text adjustment, graphics placement, and the like) for said

graphics and text. The “predeterminable profile” of claim 1 is described on pages 10-12 and Figs. 5, 7, and 13, as a structured set of field-specific information, such as a company or personal name, a title, an address, a telephone number, a fax number, a website address, and an email address. As described on page 9, lines 20-23 and page 12, lines 10-14, the “predeterminable profile” may additionally comprise information both defining and limiting the range of products to be made available to a particular level of personnel within a company. For example, secretaries may be given a selection of stationery products, such as envelopes and letterhead, to choose from, but not be given the opportunity to request business cards for themselves. But other members of the company or organization may be given selection options for a different range of products.

Illuminated by this context, claim 1 covers an “automated print order system” that provides both a requestor interface to enable a user to select a company tailored product (e.g., business cards or letterhead with company-specific graphics and layout) according to a predeterminable profile (e.g., user and/or company indicative information) and to make a print order therefrom, and a processor interface to fulfill the user’s print order, the processor interface automatically incorporating the predeterminable profile (e.g., user and company indicative information) into the tailored product (e.g., business card or letterhead with company-specific graphics and layout) and directly generating a pre-press product (e.g., ready-to-print PDF) therefrom.

Sevcik does not disclose, teach, or suggest a system or process for automatically incorporating a predeterminable profile into a tailored product and directly generating a pre-press

product therefrom. On the contrary, it anticipates that “a Print Provider may require additional information about a job in order to begin.” Col. 15, lines 19-22.

In his Office Action, the Examiner asserted that “Sevcik merges specific profile data, data entered via entry fields on various interfaces according to templates and prototypes to produce pre-press files.” Office Action, at 6. Applicant respectfully disagrees. A specification that a print buyer wants 2500 6-inch-by-9-inch white postcards having a 10-pound paper weight with a glossy finish with 3 panels, color ink on the front, and black ink on the back (Sevcik, Fig. 5) is not a “pre-press” product or file. These specifications are simply used to generate a quote or print order – not a pre-press product or file. Moreover, as indicated by col. 15, lines 19-22, the Print Provider will generally require additional information about the job – *like what information and graphics need to be put on the letterhead, postcards, or address labels, and the typesetting desired for the print product* – before it can begin. Sevcik simply does not automate this process.

Interestingly, Sevcik discusses user profile information on column 14, lines 8-22. But Sevcik provides no disclosure or suggestion that the user profile information can or should be automatically merged with a template for a print product, thereby addressing the typesetting and proofing inefficiencies of the prior art. Sevcik indeed has several interesting elements – among them, a database, a print buyer interface, a print buyer profile, and a print provider interface. But Sevcik did not combine them in the fashion the Examiner believes, in hindsight, it is so obvious to do. This raises a strong inference that Sevcik and his co-inventors lacked any motivation to combine them as the Examiner suggests.

When one thinks about it, it is hard to imagine any *practical* motivation to modify Sevcik to include an automatic merging process. After all, Sevcik's system is a platform for creating a common marketplace for competing print providers. A provider of such a platform would have an overriding motivation to host as many print providers as possible. Corporate print buyers expect and demand maximum creative freedom in designing business cards and stationery, and print providers want the freedom to satisfy those expectations. Therefore, to make such a platform commercially viable, a platform provider could not restrict print providers from tailoring their print products to the graphical and typographic needs of their corporate consumers. But if one were to modify Sevcik's system to include an automatic merging process, the graphical designs, text fields, and typography would necessarily be limited to a finite range of templates. And if Sevcik's system itself generated the pre-press product, then only print providers with compatible pre-press systems could use it. Either print providers would have to adopt common pre-press systems compatible with Sevcik's pre-press products and be content with offering their customers with only a limited range of predetermined templates, or the Sevcik system would have to be complex enough to generate any of the scores of pre-press products its various print providers used and flexible enough to incorporate any template that any one of the many print providers customized for its customers. The former constraint would have no reasonable hope of commercial success, because print providers would not adopt it. The latter constraint has no reasonable hope of technical or commercial success, because it would be extremely complex, unwieldy, and prohibitively expensive.

The Examiner nevertheless argues that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time the invention was made to include in Sevcik

the use of various types of command sets known in the prior art and disclosed by the applicant.”
Office Action, at page 7.

“When an obviousness determination is based on multiple prior art references, there must be a showing of some ‘teaching, suggestion, or reason’ to combine the references.” *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). “The absence of such a suggestion to combine is **dispositive** in an obviousness determination.” *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 (Fed. Cir. 1997) (emphasis added). The Federal Circuit has repeatedly demanded a “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references” as an antidote to “the subtle but powerful attraction of a hindsight-based obviousness analysis.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). “Actual evidence” of a suggestion, teaching, or motivation to combine is required. *Id.* “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *Id.*

It is clear that Sevcik itself does not provide any suggestion, teaching, or motivation to combine the elements disclosed therein with the prior art disclosed in Applicant’s specification. Moreover, the prior art disclosed in Applicant’s specification predated Sevcik. Therefore, it is doubtful that any references that may describe them would provide any suggestion, teaching, or motivation to be combined with Sevcik.

The Examiner argues that Smith et al., U.S. Patent No. 5,964,156 and several articles on professional publishing software somehow supply the suggestion and motivation to combine. Office Action at pages 13-14. The undersigned reviewed these references, but found no hint of any suggestion or motivation to make the supposedly obvious combination. Applicant

respectfully notes that “actual evidence” – not a broad conclusory statement – of a suggestion, teaching, or motivation to combine is required.

Furthermore, there is no indication that a person of *ordinary* skill in the art, without the benefit of Applicant’s specification, would know how to combine or modify the prior art in order to practice Applicant’s claimed invention. A showing of obviousness requires not only a motivation or suggestion to combine or modify prior art references, but also a reasonable expectation of success. *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1354 (Fed. Cir. 2003); *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991) (reversing obviousness rejection where there was no reasonable expectation of success). Dreams of getting a man on the moon existed many centuries before the successful Apollo mission in 1969. Those dreams, and the desire and motivation that accompanied them, could not alone make the technology that got man to the moon “obvious.”

It is the undersigned’s understanding that the Applicant invested over \$200,000 to develop software capable of practicing the claimed invention. Applicants’ extensive efforts “tend to show that one skilled in the art would have had no reasonable expectation of success in combining the prior art . . . in question.” *Micro Chem., Inc. v. Great Plains Chem. Co.*, 103 F.3d 1538, 1547 (Fed. Cir. 1997). The undersigned is prepared, if necessary, to confirm that understanding and supply an affidavit to overcome the Examiner’s obviousness rejection.

These foregoing arguments, which are pertinent to claim 1, are likewise pertinent to dependent claims 2-20, for if claim 1 is allowable over the prior art, so are all of its dependent claims.

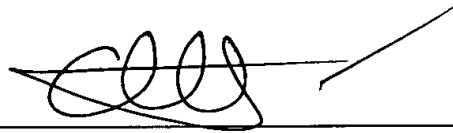
Applicant respectfully asks that the section 103 rejection be withdrawn.

Appl. No. 09/487387
Amdt. dated June 10, 2003
Reply to Office Action of February 11, 2003

CONCLUSION

Having addressed all matters raised by the Examiner's February 11, 2003, Office Action, Applicants respectfully request that the claims be allowed.

Respectfully submitted,

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke, positioned above a solid horizontal line.

Charles W. Hanor
Reg. No. 27132
Phone: (210) 886-9500
Fax: (210) 886-9883
e-mail: chanor@hanor.com

Please continue to forward all future correspondence to:

Charles W. Hanor
Gunn, Lee & Hanor
700 N. St. Mary's Street
Suite 1500
San Antonio, Texas 78205

ATTORNEY FOR APPLICANTS